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42

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/053,264	01/23/2002	David Henry Levy		8694
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FISH & RICHARDSON PC 225 FRANKLIN ST BOSTON, MA 02110			EXAMINER ORTIZ, BELIX M	
			ART UNIT	PAPER NUMBER
			2164	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/053,264

Applicant(s)

LEVY, DAVID HENRY

Examiner

Belix M. Ortiz

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12-20-04
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Remarks

1. In response to communications files on 20-December-2004, claims 1-2 are cancelled; claims 3-9 are amended; and claims 10-26 are added per applicant's request. Therefore, claims 3-26 are presently pending in the application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 3-7, 10-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Padwick et al.

As to claim 3, Padwick et al. teach a system comprising:

an electronic document generation module configured to allow a user to generate an electronic document (see page 1, paragraph 4-12);

an input device configured to receive from a user a predefined string of characters for entry into the electronic document, wherein the predefined

string of characters represents information that is to be inserted into the electronic document (see page 4, figure 3.30),

an active messaging module configured to recognize the predefined string of characters and, in response automatically open a messaging window on a display that permits the user to compose a message requesting the information that is to be inserted into the electronic document from one or more recipients (see Page 2 paragraph 2 and page 4 figure 3.30 and paragraph 4).

As to claim 4, Padwick et al. teach wherein said message window includes:

a context window, said context window to include a subset of said document proximate the location of said predefined string of characters (see page 4, figure 3.30).

As to claim 5, Padwick et al. teach wherein the active messaging module is further configured receive a response from a recipient and display the response to the user (see page 26, paragraph 10).

As to claim 6, Padwick et al. teach wherein the active messaging module is further configured to automatically integrate the response into the electronic document in response to receiving approval from the user (see page 26, paragraphs 10-11 and page 27, figure 3.48 and paragraphs 2-3).

As to claim 7, Padwick et al. teach wherein the active messaging module is further configured to permit the user to edit the response (see page 29, paragraph 2).

As to claim 10, Padwick et al. teach wherein the active messaging module is further configured to automatically integrate an edited response into the electronic document (see page 26, paragraphs 10-11 and page 27, figure 3.48 and paragraphs 2-3).

As to claim 11, Padwick et al. teach a method comprising:

entering a predefined string of characters into an electronic document by a user, wherein the predefined string of characters represents information that is to be inserted into the document (see page 1, paragraphs 4-11 and page 4, figure 3.30); and

by machine, recognizing the predefined string of characters in the electronic document and, in response to a recognition of the predefined string of characters, automatically opening a messaging window on a display that permits the user to request the information that is to be inserted into the electronic document from one or more recipients (see page 2, paragraph 2 and page 4, figure 3.30 and paragraph 4).

As to claim 12, Padwick et al. teach wherein the message window includes a portion of the electronic document surrounding the predefined string of characters (see page 4, figure 3.30).

As to claim 13, Padwick et al. teach the method further comprising:
enabling the user to vary the portion of the electronic document that is included in the message window (see page 29, paragraphs 1-2).

As to claim 14, Padwick et al. teach wherein the message further includes a messaging area in which the user can enter a message to the one or more recipients (see page 1, paragraph 9; page 4, figure 3.30 and paragraph 5; and page 7, figure 3.32).

As to claim 15, Padwick et al. teach wherein the one or more recipients includes a person (see page 1, paragraph 9; page 4, figure 3.30 and paragraph 5; and page 7, figure 3.32).

As to claim 16, Padwick et al. teach wherein the predefined string of characters comprises a single character (see page 4, figure 3.30 and page 9, figure 3.33).

As to claim 17, Padwick et al. teach the method further comprising:
transmitting a message containing a request for the information that is
to be inserted into the document to the one or more recipients (see page 1,
paragraph 11).

As to claim 18, Padwick et al. teach the method further comprising:
receiving a response back from one or more of the recipients (see
page 29, paragraphs 1-2).

As to claim 19, Padwick et al. teach the method further comprising:
displaying the response to the user (see page 29, paragraphs 1-2);
and
enabling the user to approve the response before it is inserted into
the electronic document (see page 26, paragraph 11).

As to claim 20, Padwick et al. teach the method further comprising:
automatically inserting the response into the electronic document
upon approval from the user (see page 26, paragraph 11 and page 29,
paragraph 2).

As to claim 21, Padwick et al. teach a computer-implemented
method comprising:

transmitting an electronic message containing a request for the information that is to be inserted into an electronic document to one or more recipients, wherein the message includes a portion of the electronic document surrounding a location of where the information is to be inserted (see page 1; page 2, paragraph 2; and page 4, figure 3.30 and paragraph 4);

receiving a response back from one or more of the recipients (see page 29, paragraphs 1-2); and

automatically inserting the response into the electronic document (see page 29, paragraph 2).

As to claim 22, Padwick et al. teach the method further comprising:

displaying the response to the user (see page 29, paragraphs 1-2);
and

enabling the user to approve the response before it is automatically inserted into the electronic document (see page 26, paragraph 11).

As to claim 23, Padwick et al. teach wherein automatically inserting the response into the electronic document (see page 29, paragraphs 1-2) comprises:

automatically inserting the response into the electronic document upon approval from the user (see page 26, paragraphs 10-11 and page 27, figure 3.48 and paragraphs 2-3).

As to claim 24, Padwick et al. teach the method further comprising:
displaying the response to the user (see page 29, paragraphs 1-2);
and
enabling the user to edit the response before it is automatically
inserted into the electronic document (see page 26, paragraph 11).

As to claim 25, Padwick et al. teach wherein automatically inserting
the response into the electronic document comprises:
automatically inserting the response into the electronic document
upon approval from the user (see page 26, paragraphs 10-11 and page
27, figure 3.48 and paragraphs 2-3).

As to claim 26, Padwick et al. teach wherein the electronic
message further includes a messaging area in which the user can enter a
message to the one or more recipients (see page 1, paragraphs 4-12).

4. The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made
in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another
filed in the United States before the invention thereof by the applicant for patent, or on an
international application by another who has fulfilled the requirements of paragraphs (1), (2),
and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claim 8 is rejected under 35 U.S.C. 102(e) as being anticipated by Brown (U.S. patent 6,014,711).

As to claim 8, Brown teaches a computer-implemented method (see column 1, lines 6-13) comprising:

receiving a predefined string of characters into an electronic document entered by a user, wherein the predefined string of characters represents a user-defined unknown (see column 3, lines 12-31);

recognizing the predefined string using a first computing device, and, in response to recognizing the predefined string automatically assembling a query that includes a set of context data extracted from text a portion of-the electronic document disposed proximate to user-defined unknown (see column 3, lines 12-31);

transmitting the query to a database located remotely from the first computing device (see column 3, lines 12-31);

searching the database for information responsive to the user-defined unknown using information contained in the query (see column 3, lines 12-31); and

transmitting a response containing responsive information to the first computing device (see column 3, lines 12-31).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (U.S. patent 6,014,711) as applied to claim 8 above, and further in view of Padwick et al.

As to claim 9, Brown does not teach the method further comprising: automatically inserting the responsive information into the electronic document in response to receiving an approval from the user.

Padwick et al. teaches creating, sending, and receiving electronic document (see manual), in which he teaches the method further comprising:

automatically inserting the responsive information into the electronic document in response to receiving an approval from the user (see page 26, paragraphs 10-11 and page 27, figure 3.48 and paragraphs 2-3).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Brown, to include the method further comprising:

automatically inserting the responsive information into the electronic document in response to receiving an approval from the user.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Brown by the teaching of Padwick et al., because the method further comprising:

automatically inserting the responsive information into the electronic document in response to receiving an approval from the user, would enable the method because, the user know if the recipient open the message and read it.

Response to Arguments

8. Applicant's arguments filed 20- December- 2004 with respect to the rejected claims in view of the cited references have been fully considered but they are not found persuasive:

In response to applicants' arguments that "Gough nor Birrell, fail to teach or suggest an active messaging module configured to recognize the

Art Unit: 2164

predefined string of characters and, in response automatically open a messaging window on a display that permits the user to compose a message requesting the information that is to be inserted into the electronic document from one or more recipients”, the arguments have been fully considered but are not deemed persuasive, because Padwick et al. teaches the response automatically open a messaging window on a display that permits the user to compose a message (see Padwick et al., page 2, paragraph 2 and page 4, figure 3.30).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory

Art Unit: 2164


period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Belix M. Ortiz whose telephone number is 571-272-4081. The examiner can normally be reached on Monday-Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici can be reached on 571-272-4083. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

bmo

March 12, 2005


SAM RIMELL
PRIMARY EXAMINER